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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/740,679	12/19/2000	J. Stuart Cumming	P02087US1	6074

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EXAMINER

ROBERT, EDUARDO C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/740,679

Applicant(s)

CUMMING, J. STUART

Examiner

Eduardo C. Robert

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/8/03 & 1/12/04.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 53-102, 104 and 105 is/are pending in the application.
- 4a) Of the above claim(s) 58, 60, 62, 64-72, 75, 76, 78-89 and 91-98 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 53-57, 59, 61, 63, 73, 74, 90, 99, 102, 104-106 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Art Unit: 3732

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 12, 2004 has been entered.

### ***Election/Restrictions***

Applicant's argument with regard claim 77 is persuasive and the examiner agrees that claim 77 reads on the elected species, i.e. Figure 18.

The status of the claims is the following:

Claims 58, 60, 62, 64-72 75, 76, 78-89, and 91-98 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species.

Claims 53, 90, 105 are generic.

### ***Drawings***

New corrected drawings are required in this application because the proposed drawing correction filed on June 2, 2003 was approved (see Office Action Summary mailed on September 10, 2003, paper no. 18, Item. 11 Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no

Art Unit: 3732

longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 53-57, 59, 61, 63, 73, 74, 90, 99, 102, and 104-106 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,197,059, over claims 1-8 of U.S. Patent No. 5,476,514, and over claims 1-42 of U.S. Patent No. 5,674,282. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the application and the claims of the patents '059, '514, and '282 lies in the fact that the patent claims includes more elements and are more specific. Thus, the invention of the patent claims are in effect a "species" of the "generic" invention of the claims of the application. It has been held that the generic invention is "anticipated" by the "species". See *In re Goodman*, 29 USPQ2d

Art Unit: 3732

2010 (Fed. Cir. 1993). Since the claims of the application are anticipated by the claims of the patents '059, '514, and '282, they are not patentably distinct from the claims of the patents.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 53-57, 59, 61, 63, 73, 74, 90, and 105 are rejected under 35 U.S.C. 102(b) as being anticipated by Tennant (Reference U.S. Pat. 4,254,509 on PTO-1449).

Tennant discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic, and haptics having inner ends joined to opposite sides of the optics and opposite outer ends. The haptics are movable anteriorly and posteriorly relative to the optic.

Claims 53-57, 59, 61, 63, 73, 74, 90, and 105 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlegel (Reference U.S. Pat. 4,424,597 on PTO-1449).

Schlegel discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic, and haptics having inner ends joined to opposite sides of the optics and opposite outer ends. The haptics are movable anteriorly and posteriorly relative to the optic.

Claims 53-57, 59, 61, 63, 73, 74, 90, 99, 102, and 105 are rejected under 35 U.S.C. 102(b) as being anticipated by Schlegel (Reference U.S. Pat. 4,673,406 on PTO-1449).

Schlegel discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic, and haptics having inner ends joined to opposite sides of the optics and opposite outer ends. The haptics are movable anteriorly and posteriorly relative to the optic. The bulge and/or notches 16 are considered the fixation means.

Art Unit: 3732

Claims 53-57, 59, 61, 63, 73, 74, 90, and 105 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kalb (Reference U.S. Pat. 4,585,457 on PTO-1449)

Kalb discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic having an optic axis, and a plurality of extended portions extending generally radially out from the optic. Each of extended portions having inner ends joined to opposite sides of the optics and opposite outer ends. The extended portions are movable anteriorly and posteriorly relative to the optic.

Claims 53-57, 59, 61, 63, 73, 74, 90, 105 are rejected under 35 U.S.C. 102(b) as being anticipated by Portnoy (Reference U.S. Pat. 4,759,761 on PTO-1449).

Portnoy discloses an intraocular lens comprising a lens body having anterior and posterior sides, an optic having an optic axis, and a plurality of extended portions extending generally radially out from the optic. Each of extended portions having inner ends joined to opposite sides of the optics and opposite outer ends. The extended portions are movable anteriorly and posteriorly relative to the optic. It is noted that one of optics embodiment of Portnoy has the posterior surface convexly curved to a substantially steeper convex curvature than the anterior surface (see Figure 2b).

### ***Response to Arguments***

Applicant's arguments filed on January 16, 2004 and December 8, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that Tennant lens is to be placed in the anterior chamber as versus the capsular or bag, it is noted that the manner in which a device is intended to

Art Unit: 3732

be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

In response to applicant's argument that Tenant is vaulted anteriorly as versus uniplanar, that Tenant does not have a groove or hinge across the haptic as versus applicant's groove, and that the Tennant optic and plate haptics are from different materials and those of the present application are the same, it is noted the limitations on which the Applicant relies are not stated in the claims. Therefore, it is irrelevant whether the reference includes those features or not.

In response to applicant's argument that Tennant's optic is rigid and the present optic is flexible, it is noted that Tennant discloses that the optic or lens 9 can be made from rigid material or soft material (see col. 2, lines 15-20). It is noted that soft materials have inherently some degree of flexibility. With regard applicant's argument about the term "solid", it is noted that a definition for "solid" is "Of definite shape and volume; not liquid or gaseous." (*The American Heritage Dictionary of the English Language*, Third Edition 1992 by Houghton Mifflin Company.). Thus, the optic of Tennant has definite shape and volume, thus it is considered a "solid".

In response to applicant's argument that Schlegel does not disclose a lens that is not accommodating, it is noted that the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ2d 1647 (1987).

In response to applicant's argument that Kalb is not solid, it is noted that a definition for "solid" is "Of definite shape and volume; not liquid or gaseous." (*The American Heritage Dictionary of the English Language*, Third Edition 1992 by Houghton Mifflin Company.). Thus, the optic of Kalb has definite shape and volume, thus it is considered a "solid". It is noted that

Art Unit: 3732

the term "solid" has not defined in the application as originally filed. Thus, a generic definition is applicable.

In response to applicant's argument that Portnoy is not a lens for accommodating, it is noted that the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

#### ***Allowable Subject Matter***

Claims 106 and 104 would be allowable if a timely filed terminal disclaimer in compliance with 37 CFR 1.321 (c) is filed to overcome the double patent rejection set forth in this Office Action.

#### ***Conclusion***

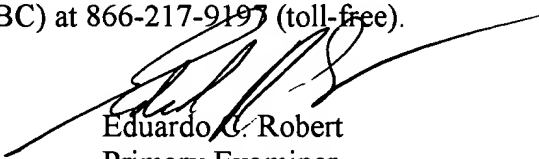
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Art Unit: 3732

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Eduardo C. Robert  
Primary Examiner  
Art Unit 3732

E.C.R.